**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**APPELLANT'S MAIN BRIEF ON APPEAL**

| | | | |
|---|---|---|---|
| APPLICANT(S): | James B. Kargman | DOCKET NO: | P06,0189-02 |
| SERIAL NO.: | 09/966,223 | ART UNIT: | 3621 |
| FILED: | September 28, 2001 | EXAMINER: | Backer, Firmin |
| | | CONF. NO. | 5896 |

TITLE: Method for Simplified One-Touch Ordering of Goods and Services from a Wired or Wireless Phone or Terminal

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. §41.37, Appellant submits this Brief in support of the appeal of the above-referenced application in support of the patentability of claims 1–39 finally rejected in the Final Office Action (FOA), dated May 18, 2007. A copy of the claims on appeal is attached as Appendix A. A Notice of Appeal was filed on September 18, 2007.

## TABLE OF CONTENTS

## TABLE OF AUTHORITIES

**Cases**

## REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee, IPDEV Co., an Illinois corporation, by virtue of the Assignment recorded June 19, 2007, at reel/frame 019446 / 0610.

## RELATED APPEALS AND INTERFERENCES

There are no related appeals and no related interferences known to Appellant, Appellant's Assignee, or Appellant's legal representative.

## STATUS OF CLAIMS

Claims 1–39 are on appeal, and constitute all pending claims of the application. These claims were all rejected as being obvious under 35 U.S.C. §103 over the combination of Movalli, et al. (U.S. Publication No. 2005/0004876 A1); and Walker, et al. (U.S. Patent Publication No. 2003/0149632).

## STATUS OF AMENDMENTS

Amendment E was filed on March 2, 2007, with claim amendments entered. This served as the basis for the Final Office Action.

## SUMMARY OF THE CLAIMED SUBJECT MATTER

The use of page and line numbers and reference characters in the drawings is provided by way of example and is in no way intended to limit the claimed subject matter unless expressly indicated. The independent claims are summarized below.

1. A method of electronically executing a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of: [0001,0010], Figure 2

transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor; (220), [0031]

receiving the transaction code by the order processing system associated with the vendor; [0034]

identifying the user based upon the contents of the transaction code; (230) [0034]

authenticating the transaction code; (240) [0031]

identifying a commercial transaction associated with the transaction code; [0035]

and subsequently

executing the identified commercial transaction by the vendor(250) [0038].

14. A method of electronically executing a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of: [0001, 0010], Figure 5

dialing a transaction code by the customer comprised of a telephone dial sequence onto a telephone network directed to an order processing system associated with the vendor; (520) [0029–0031, 0041]

receiving a telephone call by the order processing system as a result of the dialing of the transaction code; [0029–0032, 0041]

detecting caller identification information received by the order processing system from the telephone network in conjunction with the telephone call; (530) [0031, 0034, 0041]

detecting at least a portion of the transaction code dial sequence by the order processing system associated with the vendor; [0031, 0032]

identifying the user based upon the caller identification information received by the order processing system; (540) [0041]

identifying a commercial transaction associated with the transaction code; and subsequently [0035]

executing the identified commercial transaction by the vendor. (570) [0038]

18. A method for configuring an electronic user device for the automated execution of a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of: [0001, 0010], Figure 6

generating a transaction code comprised of encoded information associated with the commercial transaction; (610) [0046]

conveying the transaction code to the user device electronically; (620) [0047]

storing the transaction code within the user device; (630) [0047]

transmitting the transaction code by the user device to initiate the subsequent execution of the commercial transaction by the vendor with which the transaction code is associated. (220) [0031]

25. A method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial

transaction between a remotely located customer and a vendor, the method comprising the steps of: [0001,0010, 0053–0057], Figure 7

identifying the location of the user device; (720) [0053]

determining that the location of the user device conforms to a predetermined location criterion for receipt of a message; (740) [0056, 0057]

conveying the message to the user device electronically. (750) [0056]

37. A method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of: [0001, 0010, 0063], Figure 8

identifying the current location of the user device; (810) [0063]

identifying the direction and rate at which the user device is moving; (820) [0063]

determining that the location, direction of travel and rate of travel of the user device conform to one or more predetermined criterion for receipt of a message; (830) [0064]

conveying the message to the user device electronically. (840) [0064]

## GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue on appeal is whether the subject matter of claims 1–39 is obvious in view of Movalli, et al. (U.S. Publication No. 2005/0004876 A1); and Walker, et al. (U.S. Patent Publication No. 2003/0149632)

## ARGUMENT HEADING — REJECTION OF CLAIMS 1–39 UNDER 35 U.S.C. §103

***Subheading 1 – Obviousness of Claims 1–13***

***Examiner's Position: Claim 1 is Obviated by the Combination of Movalli and Walker because Movalli teaches all elements of claim 1 except transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor. This lack of teaching is provided by Walker. It would have been obvious to combine the two because this would enhance the flexibility of the transaction system and because Movalli and Walker are in the same environment and analogous.***

In the FOA, on p. 2–3, the Examiner stated:

> As per claim 1, 18, Movalli et al teach a method of electronically executing a commercial transaction between a customer and a vendor, the method comprising transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor; receiving the transaction code by the order processing system associated with the vendor; identifying the user based upon the contents of the transaction code; authenticating the transaction code; identifying a commercial transaction associated with the transaction code; and executing the identified commercial transaction *(see figs 4, 5, paragraphs 0046-0051).*
>
> Movalli et al fail to teach transaction between a remotely located customer and a vendor. However, Walker et al teach transaction between a remotely located customer and a vendor *(see fig 1, pps 0044, 0045).* Therefore it would have been obvious to one of ordinary skill in the art at the time between a remotely located customer and a vendor because this would have enhance the flexibility of the transaction system

In the Response to Arguments section, on pp. 11–12, the Examiner stated:

> a. Applicant(s) argue that the prior art Movalli et al taken alone or in combination with Walker et al fail to teach or suggest identifying the user based on the content of the transaction code. Examiner respectfully disagrees with Applicant(s) characterization of Movalli et al's disclosure.

Movalli et al teach among other things a method of generating tamper resistant secure endorsed transactions comprised of transaction data representative of transactions, *unique human identifiers corresponding to at least one party (emphasis added),* called first party, endorsing a transaction, and public keys corresponding to at least a second party endorsing a transaction. The public keys have corresponding private keys maintained in secret by the second party.

The method has three steps, which are performed by a data processing system. First, the system receives a transaction data, a unique human identifier, and a public key. Next, a unique code is generated from the transaction data, the unique human identifier, and the public key. *The unique code constitutes a secure endorsement of the transaction data by the first party.*

Lastly, using a private key corresponding to the received public key, a digital signature is generated by encrypting the unique code using the private key. The digital signature constitutes a secure endorsement of the transaction data by the second party.

Furthermore Movalli et al teach a credit card transaction receipt, with a unique human identifier 220 associated with an individual, for example, a credit card holder, who has endorsed the transaction, in this example, a credit card transaction, and to generate *a unique code 240 based on the combination that is representative of the endorsed transaction. As shown, both transaction data 210, which is data representative of a transaction and may include, among other items, date, time, merchant identification, sale items, prices, and taxes, as well as printer language commands, form description language commands, form definition commands, and a unique human identifier 220, which may be a digitized signature, biometric, retinal pattern, and finger print, or the like, are provided to a unique code processor 230 that generates a unique code corresponding to the inputs 210 and 220 (emphasis added).* The unique code generated in Movalli et al's disclosure is directly link to the customer and the content of the transaction as shown above.

b. In response to applicant's argument that there is no suggestion to combine the references, the examiner

> recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones,* 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both the disclosure of Moavili et al and Walker et al are in the same environment and analogous. Therefore, Examiner disagrees with the Applicant(s) that a prima facie case has not been established with regard to the combination of the references.

***Appellant's Position:***

*1. The Examiner has not established a prima facie case of obviousness for claims 1, 14, and 18 with regard to the combination of references. The combination of Movalli does not anticipate claims 1, 14, and 18 because it does not teach or suggest identifying the user based on the contents of the transaction code .*

**Transmitting**--As to the first element of claim 1, transmitting the transaction code from the customer to an order processing system associated with the vendor, the Examiner indicated on pp. 2–3, under numbered paragraph 3:

> Movalli et al fail to teach transaction between a remotely located customer and a vendor. However, Walker et al teach transaction between a remotely located customer and a vendor *(see fig 1, pps 0044, 0045).* Therefore it would have been obvious to one of ordinary skill in the art at the time between a remotely located customer and a vendor because this would have enhance the flexibility of the transaction system

In the Response to Arguments section on p. 13, under numbered paragraph 38(b), the Examiner stated:

> In this case, both the disclosure of Moavlli [sic] et al and Walker et al are in the same environment and

analogous.

However, Appellants assert that one would not be motivated to combine the teaching of Walker to the disclosure of Movalli to arrive at the presently claimed invention.

The first element of claim 1 requires transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor. Although the Appellant does not disagree that Walker teaches transmitting some form of an order code from the customer to the vendor, the other claim elements require that the transaction code be utilized in a specific manner, namely, to identify the user based on the transaction code. Walker states, in [0071–0072]:

> In the first interaction with the customer, the customer contacts the catalog merchant and provides identifying information (step 202).... During this contact, the customer supplies identifying information...
>
> Once communications are established between the catalog merchant and the customer, the customer order is taken by the merchant (step 206).

While recognizing that the Examiner is citing Walker for its teaching of customer to vendor transactions and not for the identification of the customer by transaction code, Walker clarifies that it is not dealing with a system involving an interaction between a customer and a credit card company (such as a system disclosed by Movalli) when it states in its background section, [0016]:

> Electronic payment systems are known for facilitating payments for electronic transactions. First Virtual, for example, permits buyers to establish credit card-based accounts, and to use a personal identification number to submit payment for an electronic transaction. The credit card payment is then handled in an off-line manner by First Virtual. Such systems have the drawback of being complicated to establish and use, as well as ultimately requiring the use of a credit card. Further, such payment systems are not universally accepted amongst merchants.

The Examiner indicated that Movalli and Walker are in the same

environment and analogous, but Appellants respectfully disagree. Although both deal with customer-based transactions, the present invention deals with vendor-based authentication, whereas Movalli deals with the storage of endorsed credit card transaction data in a secure manner and Walker merely deals with a vendor-based transaction. Since Walker identifies problematic issues in dealing with customer to credit card company transactions, one would not turn to the teaching of Walker and applying it to the teaching of Movalli to arrive at the present invention. In order to obviate the present invention, independent of the discussion above, requires more than simply locating the missing element in another reference.

As indicated in MPEP §2143.01(III), the fact that reference *can be* combined or modified is not sufficient to establish prima facie obviousness. The prior art must also suggest the desirability of the combination. Movalli discusses in its primary example a POS system, wherein a customer with a credit card makes a transaction and signs the credit card. The capturing of and bundling of signed credit card information from a remote system would not be contemplated by the system disclosed by Movalli. Although it is true that Movalli discloses other forms of transactions in paragraph [0046] (on-line insurance enrollment forms, etc.) in no case are any of these situations described as completing the execution of a transaction, as required by the claims. Therefore, there is no teaching or suggestion for combining these references in order to provide a teaching of the preparatory stages and execution of a transaction when the customer is remotely located from the vendor. Contrary to the Examiner's indication that the inclusion of Walker's transaction between a remotely located customer and a vendor into the teaching of Movalli because it would enhance the flexibility of the transaction system, Appellants respond that these teachings are directed at completely different issues and solving completely different problems, and that the inclusion of one into the other would not serve to "enhance flexibility".

It should be noted as an aside that part of the difficulty in assessing the Examiner's position with regard to the teaching of Movalli is that the Examiner has not clearly identified which elements of Movalli are being read on which

elements of the claim. The main analysis on p. 2 of the FOA simply cites to figures and paragraphs of Movalli as teaching the claimed element without any form of analysis as to how the claimed elements relate to what is disclosed in Movalli. The Response to Arguments section does contain some discussion, but again is very unclear as to how the claimed elements (in an element-by-element manner) are met by the teaching of Movalli.

**Receiving**—With regard to the step of receiving, the Examiner stated, with regard to the teaching of Movalli, on p. 12:

> The method has three steps, which are performed by a data processing system. First, the system receives a transaction data, a unique human identifier, and a public key....
>
> The unique code [240] generated in Movalli et al's disclosure is directly link[ed] to the customer and the content of the transaction as shown above.

Thus, the Examiner is equating the unique code 240 of Movalli with the claimed transaction code. However, the Examiner states that, in Movalli, the system receives a transaction data [210], a unique human identifier [220], and a public key. Appellants presume that "the system" (which is actually the workstation 110 in Movalli) referred to by the Examiner reads on the order processing system associated with the vendor, as claimed, in order to meet the "receiving" element of the claim.

However, the workstation 110 in Movalli does not *receive* a transaction code, as required by this claim element. Movalli's workstation 110 is the thing that actually creates the unique code 240 that the Examiner has implied as reading on the transaction code of the present invention. To the extent that the workstation 110 receives anything, it receives separately the transaction data 210 and the unique human identifier 220 to combine into the unique code 240 that the Examiner appears to have equated . It does not receive anything construed as a transaction code that would permit identifying the user in the subsequent claim element. Therefore, if Movalli is interpreted as reading on this element, then it cannot read on the remaining elements. And if Movalli is interpreted as reading on the remaining elements, it cannot be read on this element.

The Examiner has not identified whether the receiving entity in Movalli is the workstation 110 (as identified in paragraph [0046], et seq.) or the credit card processor (as identified in paragraph [0051]), which receives a single whole representation of a secure endorsed transaction 320, which is a combination of the transaction data 210, unique human identifier 220, and unique code 240. If the Examiner is reading the credit card processor on the claimed receiving entity, then there is no interpretation of claim 1 possible that also includes the steps of identifying the user, authenticating the transaction code, identifying a commercial transaction, and executing the identified commercial transaction. Movalli indicates [0051] that the credit card processor merely stores the data for a predetermined period of time. Therefore, the Examiner's has failed to demonstrate how Movalli teaches the receiving step.

**Identifying the user**—With regard to the step of identifying, the Examiner states:

> Next, a unique code is generated from the transaction data, the unique human identifier, and the public key. *The unique code constitutes a secure endorsement of the transaction data by the first party.*
>
> Lastly, using a private key corresponding to the received public key, a digital signature is generated by encrypting the unique code using the private key. The digital signature constitutes a secure endorsement of the transaction data by the second party.
>
> Furthermore Movalli et al teach a credit card transaction receipt, with a unique human identifier 220 associated with an individual, for example, a credit card holder, who has endorsed the transaction, in this example, a credit card transaction, and to generate *a unique code 240 based on the combination that is representative of the endorsed transaction. As shown, both transaction data 210, which is data representative of a transaction and may include, among other items, date, time, merchant identification, sale items, prices, and taxes, as well as printer language commands, form description language commands, form definition commands, and a unique human identifier 220, which may be a digitized signature, biometric, retinal pattern, and finger print, or the like, are provided to a unique code processor 230*

> *that generates a unique code corresponding to the inputs 210 and 220 (emphasis added).* The unique code generated in Movalli et al's disclosure is directly link to the customer and the content of the transaction as shown above.

The Examiner has gone to great lengths to identify that the unique code 240 contains the human identifier 220, but has failed to show that the user is actually *identified* based on the contents of the transaction code, as required by claim 1. Since Movalli deals with the situation of archiving of an endorsed transaction ([0049], "[the] single whole representation of the secure endorsed transaction[] may be stored in the hard disk 160, floppy disk 170, or another storage device...", and [0051], "the single whole representation of the secure endorsed transaction 320 [] can be transmitted to the credit card processor, where the data is stored for a predetermined period of time". In such a storage capacity, it would not be necessary to identify the user based on the content of the transaction code, even if the code contained information identifying the user.

Therefore, the Examiner has failed to indicate how Movalli teaches identifying the user based on the contents of the transaction code.

**Identifying a commercial transaction**—The Examiner has not indicated how Movalli discloses identifying a commercial transaction associated with the transaction code. Similar to the argument presented above, the Examiner, on p. 12, has extensively indicated how Movalli's unique code 240 comprises transaction data 210, but has failed to show how a commercial transaction is identified with respect to it.

Furthermore, tying the claim 1 language with the subsequent step of executing the identified commercial transaction, it is clear that identifying the commercial transaction in the present invention must be one that is not yet executed. However, the transaction data in Movalli includes a transaction date and time [0046], meaning that Movalli's transaction has already been executed.

Therefore, the Examiner has failed to indicate how Movalli teaches identifying the commercial transaction associated with the transaction code.

**Executing**—The Examiner has not indicated any portion of Movalli that

relates to executing any form of transaction, particularly not one based on the identified commercial transaction. The Examiner has indicated how Movalli teaches the aggregated secure endorsed transaction can be stored on a hard disk, and how a stored transaction can be checked to see if it has been tampered with. The Examiner also indicated how the secure endorsed transaction can be processed, such as being displayed, faxed, printed, etc. However, none of these disclosures relates to the "executing" of the transaction by the vendor, or would one of ordinary skill in the art construe it as such.

Movalli lacks the elements of the present invention because it deals with a different problem—the storing and verification of an already-executed transaction (or at least evidence of an already-executed transaction). In Movalli, the information 210 related to an endorsed transaction (e.g., a credit card transaction receipt [0046]) is combined with a unique human identifier 220. A unique code 240 is generated from this, but the purpose of this code is not for execution of the transaction, as required by the claims, but rather for storage and possible subsequent verification of integrity. But Movalli does not concern itself with the execution of the transaction itself.

Appellant relies on the above arguments for the non-obviousness of claims 2–13, which depend directly or indirectly from claim 1.

***Subheading 2 – Obviousness of Claims 14–17***

***Examiner's Position: Claim 14 is Obviated by the Combination of Movalli and Walker because Movalli teaches all elements of claim 14 except transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor. This lack of teaching is provided by Walker. It would have been obvious to combine the two because this would enhance the flexibility of the transaction system and because Movalli and Walker are in the same environment and analogous.***

In the FOA, on pp. 5–6, the Examiner cited the claimed elements that are disclosed by Movalli and cited to sections of Movalli that purportedly disclose the claimed features, and similarly cited the claimed elements that are purportedly disclosed by Walker and provided a reason as to why these references would be obvious to combine to arrive at claim 14.

***Appellant's Position: The Examiner has failed to establish a prima facie case of obviousness in that he has only listed the claim elements and cited portions of the Movalli reference with no effort to link the claimed elements with the teaching of Movalli.***

With regard to claim 14, the Examiner has failed to establish a prima facie case of obviousness, but rather has simply listed the claim elements and cited figures and paragraphs from Movalli. The Examiner has made no attempt to link up the claimed elements with the disclosure of Movalli. As noted in MPEP 2143.03:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this case (as well as with claim 1), the Examiner has failed to indicate how all claim limitations are taught or suggested by the prior art.

The Examiner has failed to show how Movalli teaches:

dialing a transaction code by the customer comprised of a telephone dial sequence onto a telephone network directed to an order processing system associated with the vendor;

receiving a telephone call by the order processing system as a result of the dialing of the transaction code;

detecting caller identification information received by the order processing system from the telephone network in conjunction with the telephone call;

detecting at least a portion of the transaction code dial sequence by the order processing system associated with the vendor;

identifying the user based upon the caller identification information received by the order processing system;

identifying a commercial transaction associated with the transaction code; and subsequently

executing the identified commercial transaction by the vendor.

The burden rests with the Examiner for establishing a prima facie case of obviousness, not with the Applicants for establishing a prima facie case of non-obviousness. For this reason, Appellants assert that the Examiner has not met the burden of establishing obviousness for claim 14, and thus has not met the burden with regard to claims 15–17 that depend directly or indirectly from claim 14.

***Subheading 3 – Obviousness of Claims 18–24***

***Examiner's Position: Claim 18 is Obviated by the Combination of Movalli and Walker because Movalli teaches all elements of claim 18 except transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor. This lack of teaching is provided by Walker. It would have been obvious to combine the two because this would enhance the flexibility of the transaction system and because Movalli and Walker are in the same environment and analogous.***

In the FOA, on pp. 2–3, the Examiner cited the claimed elements that are disclosed by Movalli and cited to sections of Movalli that purportedly disclose the claimed features, and similarly cited the claimed elements that are purportedly disclosed by Walker and provided a reason as to why these references would be obvious to combine to arrive at claim 18.

The Examiner failed to distinguish between the different claimed elements with regard to claim 18 as distinguished from those of claim 1.

***Appellant's Position: The Examiner has failed to establish a prima facie case of obviousness in that he has only listed the claim elements and cited portions of the Movalli reference with no effort to link the claimed elements with the teaching of Movalli.***

With regard to claim 18, the Examiner has failed to establish a prima facie case of obviousness, but rather has simply listed the claim elements and cited figures and paragraphs from Movalli. The Examiner has made no attempt to link up the claimed elements with the disclosure of Movalli. As noted in MPEP 2143.03:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or

> suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this case (as well as with claims 1 and 14), the Examiner has failed to indicate how all claim limitations are taught or suggested by the prior art.

The Examiner has failed to show how Movalli teaches:

generating a transaction code comprised of encoded information associated with the commercial transaction;

conveying the transaction code to the user device electronically;

storing the transaction code within the user device;

transmitting the transaction code by the user device to initiate the subsequent execution of the commercial transaction by the vendor with which the transaction code is associated.

In particular, the Examiner has failed to indicate any element of Movalli that would read on the claimed user device.

The burden rests with the Examiner for establishing a prima facie case of obviousness, not with the Applicants for establishing a prima facie case of non-obviousness. For this reason, Appellants assert that the Examiner has not met the burden of establishing obviousness for claim 18, and thus for claims 19–24.

***Subheading 4 – Obviousness of Claims 25–36***

***Examiner's Position: Claim 25 is Obviated by the Combination of Movalli and Walker because Movalli teaches all elements of claim 25 except transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor. This lack of teaching is provided by Walker. It would have been obvious to combine the two because this would enhance the flexibility of the transaction system and because Movalli and Walker are in the same environment and analogous.***

In the FOA, on pp. 7–8, the Examiner cited the claimed elements that are disclosed by Movalli and cited to sections of Movalli that purportedly disclose the claimed features, and similarly cited the claimed elements that are purportedly

disclosed by Walker and provided a reason as to why these references would be obvious to combine to arrive at claim 25.

***Appellant's Position: The Examiner has failed to establish a prima facie case of obviousness in that he has only listed the claim elements and cited portions of the Movalli reference with no effort to link the claimed elements with the teaching of Movalli.***

With regard to claim 25, the Examiner has failed to establish a prima facie case of obviousness, but rather has simply listed the claim elements and cited figures and paragraphs from Movalli. The Examiner has made no attempt to link up the claimed elements with the disclosure of Movalli. As noted in MPEP 2143.03:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this case (as well as with claims 1, 14, and 18), the Examiner has failed to indicate how all claim limitations are taught or suggested by the prior art.

The Examiner has failed to show how Movalli teaches:

identifying the location of the user device;

determining that the location of the user device conforms to a predetermined location criterion for receipt of a message;

conveying the message to the user device electronically.

In particular, the Examiner has failed to indicate any element of Movalli that would read on the claimed user device or determining a location of the user device.

The burden rests with the Examiner for establishing a prima facie case of obviousness, not with the Applicants for establishing a prima facie case of non-obviousness. For this reason, Appellants assert that the Examiner has not met the burden of establishing obviousness for claim 25, and thus for claims 26–36.

***Subheading 5 – Obviousness of Claims 37–39***

***Examiner's Position: Claim 37 is Obviated by the Combination of Movalli and Walker because Movalli teaches all elements of claim 37 except transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor. This lack of teaching is provided by Walker. It would have been obvious to combine the two because this would enhance the flexibility of the transaction system and because Movalli and Walker are in the same environment and analogous.***

In the FOA, on p. 10, the Examiner cited the claimed elements that are disclosed by Movalli and cited to sections of Movalli that purportedly disclose the claimed features, and similarly cited the claimed elements that are purportedly disclosed by Walker and provided a reason as to why these references would be obvious to combine to arrive at claim 37.

***Appellant's Position: The Examiner has failed to establish a prima facie case of obviousness in that he has only listed the claim elements and cited portions of the Movalli reference with no effort to link the claimed elements with the teaching of Movalli.***

With regard to claim 37, the Examiner has failed to establish a prima facie case of obviousness, but rather has simply listed the claim elements and cited figures and paragraphs from Movalli. The Examiner has made no attempt to link up the claimed elements with the disclosure of Movalli. As noted in MPEP 2143.03:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this case (as well as with claims 1, 14, 18, and 25), the Examiner has failed to indicate how all claim limitations are taught or suggested by the prior art.

The Examiner has failed to show how Movalli teaches:

identifying the current location of the user device;

identifying the direction and rate at which the user device is moving;

determining that the location, direction of travel and rate of travel of the user device conform to one or more predetermined criterion for receipt of a message;

conveying the message to the user device electronically.

In particular, the Examiner has failed to indicate any element of Movalli that would read on the claimed user device, determining a location of the user device, or determining a direction and rate at which the user device is moving.

The burden rests with the Examiner for establishing a prima facie case of obviousness, not with the Applicants for establishing a prima facie case of non-obviousness. For this reason, Appellants assert that the Examiner has not met the burden of establishing obviousness for claim 37, and thus for claims 38 and 39.

In sum, Appellant respectfully contends that the present invention as claimed in claims 1–39 is not obvious in light of Movalli and Walker.

## CONCLUSION

For the above reasons, Appellant respectfully submits that the Examiner is in error in law and in fact in rejecting claims 1–39 based on the teachings of the above-discussed references Reversal of the rejection of all of those claims is justified, and the same is respectfully requested.

This Brief is accompanied by a check in the amount of $510.00, as required by 37 C.F.R. §41.20(b)(2). If necessary, the Commissioner is hereby authorized to charge any additional fees which may be required to account No. 501519.

Respectfully submitted,

/Mark Bergner/ (Reg. No. 45,877)
Mark Bergner
SCHIFF HARDIN, LLP
Patent Department
6600 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6473

(312) 258-5779
Attorneys for Appellant
**Customer No. 26574**

5

## APPENDIX A
## CLAIMS INVOLVED IN THE APPEAL

1. (Previously Presented) A method of electronically executing a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of:

transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor;

receiving the transaction code by the order processing system associated with the vendor;

identifying the user based upon the contents of the transaction code;

authenticating the transaction code;

identifying a commercial transaction associated with the transaction code; and subsequently

executing the identified commercial transaction by the vendor.

2. (Original) The method of claim 1, where the transaction code is comprised of a telephone dialing sequence, and the step of transmitting a transaction code is comprised of the step of applying the transaction code dial sequence to a line associated with a public switched telephone network.

3. (Original) The method of claim 1, in which the transaction code is comprised of a Universal Resource Locator, and the transaction code is transmitted via the Internet.

4. (Original) The method of claim 1, in which the step of transmitting a transaction code is comprised of the step of transmitting a transaction code that

has been previously stored within digital memory associated with a wireless telephone via a

wireless communications network.

5. (Original) The method of claim 1, in which the step of identifying the user is comprised of the substeps of:

identifying the contents of a user identification data field within the transaction

code;

locating the user identification data field contents within a database accessible by

the order processing system.

6. (Original) The method of claim 3, in which the step of authenticating the transaction code is comprised of the substeps of:

identifying the contents of a security code field within the transaction code;

determining that the received transaction code is authentic when the contents of the security code field correspond to a previously-configured security code associated with the contents of the user identification data field, which previously-configured security code is stored within a database accessible by the order processing system.

7. (Original) The method of claim 3, in which the step of authenticating the transaction code is comprised of the substeps of:

identifying a decryption key associated with the contents of the user identification data field;

decrypting at least a portion of the transaction code using the identified decryption key;

determining whether the decrypted portion of the transaction code is valid.

8. (Original) The method of claim 1, in which the step of authenticating the transaction code is comprised of the substeps of:

identifying a decryption key based upon the identity of the user;

decrypting at least a portion of the transaction code using the decryption key.

9. (Original) The method of claim 1, in which the step of identifying a commercial transaction associated with the transaction code is comprised of the substeps of:

determining the contents of a transaction identification field within the transaction code;

locating the contents of the transaction identification field within a database accessible by the order processing system;

identifying the nature of the commercial transaction based upon information within the database associated with the contents of the transaction identification field.

10. (Original) The method of claim 1, in which the step of identifying a commercial transaction associated with the transaction code is comprised of the substeps of:

determining the contents of a transaction identification field within the transaction code;

identifying the nature of the commercial transaction based upon information within the transaction identification field.

11. (Original) The method of claim 1, in which the step of identifying a commercial transaction associated with the transaction code is comprised of the substeps of:

locating a record within a database associated with the order processing system based upon the identity of the user;

retrieving details of the commercial transaction from the database record associated with the user.

12 (Previously Presented) The method of claim 5, in which the database is maintained within a point of sale computer system operated by the vendor.

13. (Original) The method of claim 1, in which the step of executing the identified commercial transaction is comprised of the step of entering the identified commercial transaction into a point of sale computer system operated by the vendor.

14. (Previously Presented) A method of electronically executing a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of:

dialing a transaction code by the customer comprised of a telephone dial sequence onto a telephone network directed to an order processing system associated with the vendor;

receiving a telephone call by the order processing system as a result of the dialing of the transaction code;

detecting caller identification information received by the order processing system from the telephone network in conjunction with the telephone call;

detecting at least a portion of the transaction code dial sequence by the order processing system associated with the vendor;

identifying the user based upon the caller identification information received by the order processing system;

identifying a commercial transaction associated with the transaction code; and subsequently

executing the identified commercial transaction by the vendor.

15. (Previously Presented) The method of claim 14, in which the step of identifying a commercial transaction is comprised of the substeps of:

identifying a record in a database associated with the order processing system based upon the received caller identification information;

retrieving details of the commercial transaction from the database record associated with the received caller identification information.

16. (Previously Presented) The method of claim 14, the method further comprising the step of authenticating the user before executing the identified commercial transaction.

17. (Previously Presented) The method of claim 16, in which step of authenticating the user is comprised of the substeps of:

prompting the user to enter a passcode;

determining that the passcode entered corresponds to a passcode value previously stored within a database record associated with the caller identification information.

18. (Previously Presented) A method for configuring an electronic user device for the automated execution of a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of:

generating a transaction code comprised of encoded information associated with the commercial transaction;

conveying the transaction code to the user device electronically;

storing the transaction code within the user device;

transmitting the transaction code by the user device to initiate the subsequent execution of the commercial transaction by the vendor with which the transaction code is associated.

19. (Previously Presented) The method of claim 18, in which the electronic device is a wireless telephone, and the transaction code is stored within telephone book memory of the wireless telephone.

20. (Previously Presented) The method of claim 18, in which the electronic device is a wireless telephone, the transaction code is comprised of a telephone dialing sequence, and the transaction code is stored within telephone book memory of the wireless telephone.

21. (Previously Presented) The method of claim 18, in which the transaction code is comprised of a Universal Resource Locator.

22. (Previously Presented) The method of claim 18, in which the transaction code is conveyed to the electronic device via wireless messaging.

23. (Previously Presented) The method of claim 18, in which the step of storing the transaction code is comprised of the substeps of:

identifying wireless message as a transaction code capable of storage within the user device;

programming the transaction code into digital memory within the user device without requiring substantial intervention by the user.

24. (Previously Presented) The method of claim 18, where the transaction code is generated by a point of sale system associated with the vendor in response to a request by the customer.

25. (Previously Presented) A method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of:

identifying the location of the user device;

determining that the location of the user device conforms to a predetermined location criterion for receipt of a message;

conveying the message to the user device electronically.

26. (Previously Presented) The method of claim 25, in which the message is a transaction code which can be stored within the user device and subsequently transmitted by the user device to initiate a commercial transaction.

27. (Previously Presented) The method of claim 25, in which the step of determining that the location of the user device conforms to a predetermined criterion for receipt of a message is comprised of the step of determining that the location of the user device lies within a predetermined geographical region associated with the vendor.

28. (Previously Presented) The method of claim 25, in which the user device is a cellular telephone, and the step of identifying the location of the user device is performed via triangulation techniques implemented by the communications infrastructure with which the cellular telephone operates.

29. (Previously Presented) The method of claim 25, in which the user device includes a global positioning system receiver, and the step of identifying the location of the user device is performed by receiving location information provided by the global positioning system receiver.

30. (Previously Presented) The method of claim 25, which method further comprises the step of determining that the message satisfies one or more filter criteria preconfigured by the customer.

31. (Previously Presented) The method of claim 30, in which the filter criteria are satisfied when one or more of the following message attributes conform to predetermined user preferences: the identity of the vendor; the geographical location of the vendor; the zip code in which the vendor is located; the city in which the vendor is located; the nature of the business conducted by the vendor; the frequency with which the customer enters the area in which the vendor does business; and the frequency with which the customer receives messages from the vendor.

32. (Previously Presented) The method of claim 26, which method further comprises the step of automatically deleting the transaction code from the user device upon the satisfaction of a deletion criterion.

33. (Previously Presented) The method of claim 32, in which the deletion criterion is the expiration of a predetermined period of time since the transaction code was stored within the user device.

34. (Previously Presented) The method of claim 32, in which the deletion criterion is the transmission of the transaction code by the user device.

35. (Previously Presented) The method of claim 32, in which the deletion criterion is the transportation of the user device a predetermined distance from a location associated with the vendor.

36. (Previously Presented) The method of claim 25, in which the message is comprised of map information identifying the location of the user device and a location associated with the vendor.

37. (Previously Presented) A method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a remotely located customer and a vendor, the method comprising the steps of:

identifying the current location of the user device;

identifying the direction and rate at which the user device is moving;

determining that the location, direction of travel and rate of travel of the user device conform to one or more predetermined criterion for receipt of a message;

conveying the message to the user device electronically.

38. (Previously Presented) The method of claim 37, in which the step of determining that the location, direction of travel and rate of travel of the user

device conform to one or more predetermined criterion for receipt of a message is comprised of the substeps of:

determining the anticipated location of the user device at a predetermined time in the future based upon the current location, rate of travel and direction of travel;

determining that the anticipated location of the user lies within a predetermined region associated with the vendor.

39. (Previously Presented) The method of claim 37, in which the step of determining that the location, direction of travel and rate of travel of the user device conform to one or more predetermined criterion for receipt of a message is comprised of the substeps of:

calculating a radius of accessibility for the customer operating the user device as an estimate of the geographical region over which the customer would travel to engage in a commercial transaction, which calculation is based upon the location, rate of travel and direction of travel of the user device;

determining that a location associated with the vendor lies within the radius of accessibility.

## APPENDIX B
## EVIDENCE APPENDIX

There is no additional evidence entered and relied upon for this appeal.

## APPENDIX C
## RELATED PROCEEDINGS APPENDIX

There are no related proceedings associated with this appeal